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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,260	06/19/2001	Alan Brash	06027.0002U2	3583

23859 7590 05/14/2004
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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/884,260	Applicant(s) BRASH ET AL.	
	Examiner Maryam Monshipouri	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 20-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Applicant's response to restriction requirement filed 3/2/04 is acknowledged. Applicant elected Group IV invention directed to claims 20-231 with traverse. Claims 1-19 are withdrawn as drawn to non-elected invention.

In traversal of restriction requirement applicant argues that the examiner has not shown that a serious burden results if all claims are examined together. Applicant further adds that for a restriction to be proper, the examiner must satisfy the following two criteria: 1) the existence of independent and distinct inventions and (2) the search and examination of the entire application cannot be made without serious burden. Specifically, according to applicant, the examiner has failed to show that an examination of Group III and IV together would be a serious burden because both Groups are grouped together in the same class (i.e. class 435). Hence, in view of applicant it is most efficient if Groups III and IV be rejoined and finally restriction is withdrawn.

These arguments were fully considered but were found **unpersuasive**. This is because the examiner is not clear why applicant is of the opinion that the serious burden of searching and examination has not shown in the previous office action. If applicant reads the previous office action, more carefully he/she can clearly realize that each invention of Groups I-IV are classified in a different class and subclass. The fact that all inventions belong to class 435 does not relieve the examiner from the burden of searching because class 435 is an incredibly large class, comprising of tens of thousands of products and methods.

Further, even in rare cases, if there is some overlap between searches required for each invention, said searches are **not coextensive**. Specifically, even though, both

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Groups III and IV may require a search in class 530/350, Group II, as shown before, requires a search in class 435/134 which is totally unnecessary for Group IV invention. Thus, in contrast to applicant's view, rejoinder of all inventions or even Groups III and IV inventions **does impose** an undue burden of searching on the examiner.

Applicant is also reminded that examination of all inventions additionally, imposes an undue burden of examination on the examiner because issues such as enablement and written description, related to Groups I and II inventions are not identical to those that have to be considered for Groups III and IV inventions etc. Hence, in contrast to applicant's view rejoinder of all inventions not only does not improve the efficiency of searching and examination but it imposes so much burden on the examiner that the accuracy, precision and quality of examiner's work may be compromised.

In conclusion, in view of response provided above in addition to reasons provided in the previous office action, restriction is maintained and is hereby made **Final**.

Upon review of the previous office action, further restriction is deemed necessary as shown below:

Group IV(a): Claim 20 (in part), drawn to a method of preparing 3-(Z)-nonenal, and its corresponding alcohol, classified in class 435, subclass 147.

Group IV(b) Claim 20 (in part), drawn to method of preparing (3Z,6Z)-nonadienal, 2-(E)-nonenal, (2E,6Z)-nonandienal, or its corresponding alcohol, classified in class 435, subclass 147.

Group IV(c): Claim 20 (in part), drawn to method of preparing (2E,6Z)-nonandienal, or its corresponding alcohol, classified in class 435, subclass 147.

Group IV(d): Claim 21 (in part), drawn to a method of preparing 2-(E)-hexen-1-al, or its corresponding alcohol, classified in class 435, subclass 147.

Group IV(e): Claim 21(in part), drawn to drawn to a method of preparing 3-(Z)-hexen-1-al, or its corresponding alcohol, classified in class 435, subclass 147.

The inventions of Groups IV(a)-(e) are patentably distinct each from the other because each method has different steps and different end-points.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnanthapu Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Maryam Monshipouri Ph.D.

Primary Examiner
